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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/981,467 | 10/17/2001 | Max Stern | STN.0101 | 5932 |

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EXAMINER

CAPRON, AARON J

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,467

Applicant(s) *not*

STERN, MAX

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Mark Sager
MARK SAGER
PRIMARY EXAMINER

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-10 and 12-15 contain divergent claim language. Claims 9-10 point to a device for playing a game and claims 12-15 point to a game, while claims 1, 5, 6 and 11 point to a method. Claims 9-10 and 12-15 do not provide competitors with an accurate determination of the metes and bounds of protection involved so that an evaluation of the possibility of infringement may be ascertained with a reasonable degree of certainty.

Double Patenting

Claims 1-15 of this application conflict with claims 1-16 of Application No. 09/981,463. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Moody et al. (U.S. Patent No. 5,976,016; hereafter "Moody").

Moody discloses a poker game (abstract) that includes each game element having a selected color and playing indicia on each of the elements (3:45-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody.

Referring to claims 3-4, Moody discloses using cards, but does not disclose using a group of colored balls that are numbered from 0-9. However, the feature of balls numbered 0-9 as game elements, lacking criticality, is considered well within the capabilities of one of ordinary

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skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of balls numbered 0-9 as the game elements of Moody in order to satisfy the particular gaming theme and stand out from other similar poker games. Furthermore, Applicant suggests in the disclosure that other elements, besides a ball, can be used as long as the elements satisfy the distribution of 5 groups with each group having at least 10 elements (Page 6, line 21 to Page 7, line 3).

Referring to claim 5, Moody discloses the number of elements is five (Figure 1). Alternatively, it is notoriously well known in the art of poker to play with poker hands of three or four game elements in order to differentiate the poker type game from other poker type games and create more interest for the game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use three or four card poker hands into Moody in order to create more interest in the poker game.

Referring to claim 6, Moody discloses that players can make wagers on the game and win the game based upon a gaming table (abstract and column 4, Table I).

Referring to claims 7-10, Moody discloses that the game is controlled and played on an electronic video game machine and a computer (1:19-30).

Referring to claim 11, as shown above, Moody discloses a poker type game using game elements that can use the colors red, yellow, blue and green (3:59-63). Moody discloses at least one of the features listed in each of the claims below, but does not teach all of the features such as the color black. However, these “untaught” features are equivalent to the features that are disclosed by Moody since Moody discloses that the game elements can be differentiated by

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colors and that the color black, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games.

Claims 13-15 correspond in scope to a game set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moody et al. (U.S. Patent No. 6,098,985) discloses that the poker game can be played using 3 or 4 cards (abstract).

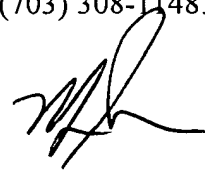
Leake (U.S. Patent No. 5,624,119) discloses using alternative symbols, such as circles, instead of the standard bingo game numbers (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



MARK SAGER
PRIMARY EXAMINER

ajc
March 20, 2003